REMARKS

Claim 12-39 are pending. Independent claim 26 is amended.

Claims 12-14, 18, 26-28, 34 and 35 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomi et aI., U.S. Patent No. 6,769,127 B1 (hereinafter Bonomi), in view of Tsao, U.S. Pre- Grant Pub. No. 2003/0079016 A1 (hereinafter Tsao), Brooks et aI., U.S. Patent No. 7,339,993 B1 (hereinafter Brooks), Reininger et aI., U.S. 6,404,738 B1 (hereinafter Reininger), and Vitikainen et aI., U.S. Pre- Grant Pub. 2003/0065802 (hereinafter Vitikainen).

Regarding claims 12 and 26: The action stated that Bonomi teaches a two part media system and method of operating such, that stores media contents and also delivers media content to an end device over a network at a data rate sufficient to enable real-time playback (*citing* [abstract], [col. 2, II. 30-36], [cols. 2-3, II. 52-4], [col. 12, II. 24-42]) and supports the delivery of media content and the quality of service (OOS) thereof (see [col. 7, II. 10-32]). Bonomi does not teach wherein the device is a network attached storage device (NAS). Tsao teaches using a NAS server to accomplish the storage and delivery of video streams to client devices (see [6], [7]).

The action concluded that, however, Bonomi does not teach storing programming in a proprietary and nonstandard digital format but that Brooks teaches using proprietary formats as a means to retrieve data (where the proprietary format is non-standard in that it is an "other format" and not a standard such as AVI, MPG, MOV, etc.) (see [col. 17, II. 23-35]). Thus, the action states that, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to use proprietary format, as taught in Brooks, when receiving and storing media content, as taught in Bonomi, because proprietary formats which encompass non-standard formats, provide added security.

In response, the applicant notes that claim 1 requires:

a two-part digital recording and playback system further including:

a first part for storing audiovisual programming in a proprietary and non-standard digital media format to preclude the digital media being played by known technology without authorization by the NAS; and

a second part to enable real-time playback of audiovisual programming stored on the NAS, wherein the NAS employs Quality of Service (QoS) operations to prioritize communications; <emphasis added with underlining>

The cited text from Brooks states:

In the present embodiment, the requesting device receives the packets of data and strips the RTP headers to recover the stream of data, step 710. The data stream is then typically 25 decompressed and then displayed on the requesting device, step 720. For example, the requesting device will retrieve MPEG-4 data, and then play that data to its display. As an example, the user may see that there is a traffic jam on the highway. In alternative embodiments, other types of formats may be used, for example, AVI, MPG, May, XING and the like. In still other embodiments, other formats, including other proprietary formats may also be specified and used by the requesting device.

Very clearly, this text describes transmitting a stream of data in any format required by the receiving device including " *AVI, MPG, May, XING and ... other formats, including other proprietary formats may also be specified and used by the requesting device".*

Thus, Brooks is teaching the away from the requirements of the claim. The claims requires a proprietary format to prevent access by the end devices which Brooks teaches formatting to support access by the end devices. Moreover, claim 1 requires a two-part system wherein the first part is for storing the data in the protected proprietary format. None of the references teach a multi-part system wherein one part is for storing data in a proprietary and protected format.

Claim 26, as presently constituted, now requires:

changing data associated with the audiovisual programming from a protected and proprietary protocol to one that can be accessed by the end device;

As discussed above, Brooks does not teach using a proprietary protocol to enhance security and to prevent unauthorized access.

The action further stated that Bonomi does not teach determining an end-to-end QoS which evaluates a hierarchy of content creation sources, transmission media and end device playback technology nor evaluating media type, a specified quality of service requirement to determining allocated bandwidth and transmission priority. However, the actions states that Reininger teaches a system which provides a dynamic allocation of bandwidth to control transmission quality priorities by using profiles and satisfaction indexes which evaluates a hierarchy (a highest satisfaction index) of content creation sources and transmission media to provide a desired of soft QoS parameters (*citing* [abstract], [col. 3, II. 40-62], [col. 4, II. 15-25], [cols. 4-5, II. 60-8], [col. 6, II. 46-56], [col. 7, II. 5-11]). Thus, the action concludes that, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to use a soft-QoS system to control the bandwidth and transmission priorities, as taught in Reininger, when providing a system designed to deliver content to clients with various receiving capabilities, as taught in Bonomi, because using this system provides a dynamic means to provide the best quality per user based on user requirements (see [abstract], [col. 10, II. 15-27]).

The action further states that while Reininger does mention taking into consideration the performance requirements of a client, the end device playback technology is not discussed. The action thus cites Vitikainen for teaching a set of parameters associated with a receiving device so that the format of the video content which is transmitted is formatted to comply with (see [abstract], [20], [23]). Thus, the action concludes that, at the time the invention was made, it would have been obvious to one of ordinary skill in the art that such end device technology parameters, as taught in Vitikainen, could be combined as a factor of the hierarchical determinations made to provide a user defined QoS, as taught in Reininger, because the quality of the content transmitted to an end device is also a significant factor in determining the necessary settings to provide a pre-established desired satisfaction index.

None of the references teach using the proprietary protocol for storing content to prevent unauthorized access to media and then modifying the protocol to one that the end device can process. Each of the cited references teaches other aspects. The applicant does not believe that

the references teach this required claim element. Accordingly, the applicant believes that the claimed invention of the independent claims 12 and 26 are novel and non-obvious over the cited art.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the references must teach or suggest all the claim limitation. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited references, and not based on applicant's disclosure. MPEP 2143, p. 2100-121 (August 2001). A patent composed of several elements is not proved obvious merely by demonstrating each element was, independently, known in the art. It is important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. *KSR International Co. v. Teleflex, et al.*, 550 U.S. ___, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007). While the Supreme Court stated that the so called teaching, suggestion, motivation (TSM) test should not be applied too strictly, it also did not do away with the TSM test. A rejection is still required to show more than the mere elements in the prior art.

KSR states:

> *Graham v. John Deere Co. of Kansas City, 383 U. S. 1, 17–18, set out an objective analysis for applying §103: "[T]he scope and content of the prior art are . . . determined; differences between the prior art and the claims at issue are . . . ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but un-solved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." While the sequence of these questions might be reordered in any particular case, the factors define the controlling inquiry. However, seeking to resolve the obviousness question with more uniformity and consistency, the Federal Circuit has employed a "teaching, suggestion, or motivation" (TSM) test, under which a patent claim is only proved obvious if the prior art, the problem's nature, or the*

knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings.

The District Court granted KSR summary judgment. After reviewing pedal design history, the Engelgau patent's scope, and the relevant prior art, the court considered claim 4's validity, applying Graham's framework to determine whether under summary-judgment standards KSR had demonstrated that claim 4 was obvious. The court found "little difference" between the prior art's teachings and claim 4: Asano taught everything contained in the claim except using a sensor to detect the pedal's position and transmit it to a computer controlling the throttle. That additional aspect was revealed in, e.g., the '068 patent and Chevrolet's sensors. The court then held that KSR satisfied the TSM test, reasoning (1) the state of the industry would lead inevitably to combinations of electronic sensors and adjustable pedals, (2) Rixon provided the basis for these developments, and (3) Smith taught a solution to Rixon's chafing problems by positioning the sensor on the pedal's fixed structure, which could lead to the combination of a pedal like Asano with a pedal position sensor.

KSR also stated "*The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art*" and that "*…claimed discoveries almost necessarily will be combinations of what, in some sense, is already known. Helpful insights, however, need not become rigid and mandatory formulas. If it is so applied, the TSM test is incompatible with this Court's precedents.*"

Thus, KSR does not overrule the TSM (teaching, suggestion, motivation) test. It merely strikes down the use of the TSM in a rigid manner that "denies recourse to common sense". As shown above, the Supreme Court found that the elements were all taught in the prior art and that there even existed art that taught putting sensors at the pivot point of the foot pedal. Thus, the court found that claim 4, which required a known foot pedal sensor to be placed at the pivot point to be obvious.

Here, a new system is presented with new functionality. The action has cited six references that purportedly teach the claim elements. The applicants believe that there is no teaching in these references that would suggest their combination is appropriate and that, under

the TSM test addressed in KSR, this group cannot be properly combined to form the rejection. Using hindsight to put a rejection together still is not allowable. Because the changes in the claimed invention are more than trivial and provide a new functionality for delivering audio visual content, the applicant does not believe that these references can properly be put together for the rejection absent a clear showing of a basis for their combination. The claim also requires elements not taught by the cited art (as shown above). Thus, the differences between the claimed invention and cited art are more than trivial.

CONCLUSION

For the above reasons, the foregoing amendment places the Application in condition for allowance. Because the cited references do not teach all of the elements of the independent claims, it is believed that the grounds of rejection are overcome. Additionally, the applicants believe that that the combination of six references is not appropriate in this case as it appears that that there is no teaching, suggestion or motivation to combine these six references without using hindsight. Therefore, it is respectfully requested that the rejection of the claims be withdrawn and full allowance granted.

Should the Examiner have any further comments or suggestions, please contact James Harrison at (214) 902-8100.

Respectfully submitted,

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